



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Offic

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/420,046 10/18/99 LIN, M. D.

H P07-43084

HM22/0313

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EXAMINER

TRAN.S

ART UNIT	PAPER NUMBER
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1615

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DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/420,046</b>	Applicant(s)	Lin
	Examiner <b>Susan Tran</b>	Group Art Unit <b>1615</b>	

Responsive to communication(s) filed on Feb 18, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-95 is/are pending in the application.

Of the above, claim(s) 21-23, 25-27, 32, 33, 37-40, and 43-52 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-20, 24, 28-31, 34-36, 41, 42, and 53-95 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 & 7

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

Receipt is acknowledged of applicants Corrected Filing Receipt filed 12/27/99, Information Disclosure Statement filed 02/03/00 and Supplemental Information Disclosure Statement filed 12/18/00, Request for Extension of Time filed 12/18/00, Amendment A filed 12/18/00, and Change of Address filed 12/18/00.

### *Election/Restriction*

1. Applicant's arguments filed 3/13/98 have been fully considered but they are not persuasive.

Applicant's election with traverse of Group I, claims 1-20, 24, 28-31, 34-36, 41, 42, 53-95, drawn to a composition comprising drug, lipid, and carrier, classified in class 424, subclass 464, and species a) coated microspheres or particles in Paper No. 6.

Claims 21-23, 25-27, 23, 33, 37-40, and 43-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Requirement for restriction practice are set forth in MPEP&803.

There are two criteria for a proper requirement for restriction between patentable distinct inventions:

1. The inventions must be distinct as claimed (see MPEP && 806.05-806.05(I)); and

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2. There must be a serious burden on the examiner if restriction is not required (see MPEP && 803.02, 806.04(a)-(j), 808.01(a) and 808.02).

The traversal is on the ground(s) that the distinctions between Group I and Group II are arbitrary and are arbitrarily applied to the instant claims, and therefore the requirement is improper. This is not found persuasive because:

A serious burden on the examiner is shown according to the criteria of MPEP&808.02, where one of the following must be supported by appropriate explanation:

1. Separate classification thereof;

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

2. A separate status in the art when they are classifiable together; and
3. A different field of search....

In the restriction requirement of 09/08/00, the examiner set forth separate classification for the two inventions to which claims were presented. Classification of the invention of Group I claims is in class 424. Classification of the invention of Group II claims is in class 426. Applicant has not alleged that either invention of Group I or Group II claims were improperly classified. Nor has applicant alleged that the classifications set forth are not "separate classifications." Thus, requirement 2 of MPEP&803 is met. For these reasons set forth above, the restriction requirement is proper.

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The requirement is still deemed proper and is therefore made FINAL.

***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-20, 24, 28-31, 34-36, 41, 42, 53-95 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 12, 15, 16-19, 25, 26, 44, 49, and 54-63 of prior U.S. Patent No. 5,977,175. This is a double patenting rejection.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600